In the Office Action, the Examiner has objected to the specification for informalities.

In particular, the Examiner asserts that there are spelling and grammatical errors throughout

the specification. Accordingly, Applicants have submitted herewith a substitute specification

in accordance with 37 CFR § 1.125 and a marked-up copy of the original specification with

the changes shown in red ink. Applicants respectfully submit that the substitute specification

includes no new matter.

Also in the Office Action, the Examiner has indicated that the specification includes

the trademark TEFLON which is not capitalized and not accompanied by generic

terminology, i.e., "®" or "TM." Applicants have corrected the specification to properly use

the trademark TEFLON® in the substitute specification.

Applicants have also hereinabove amended the Abstract of the Disclosure to correct

spelling and grammatical errors by deleting the originally filed Abstract and substituting

therefor the Abstract submitted herewith. In addition, Applicants submit herewith a marked-

up copy of the original Abstract with the changes shown in red ink.

The Examiner has also objected to Claims 1-17 as being indefinite. In particular, the

Examiner asserts that: the term "the" should be inserted before the term "image" in Claim 1,

line 6; the language "drawing of images" and "drawing images" in Claims 4-6 should be the

"the forming of images;" and Claims 5, 7, 9-11 and 15-17 include language lacking sufficient

antecedent basis. In addition, the Examiner asserts that the term "ordinary" in Claim 2, lines

3-4 is vague.

-5-

In response to this objection, Applicants have amended Claims 1 and 4-6 similarly to the Examiner's suggestions, Claims 5, 7, 9, 11 and 15-17 to provide proper antecedent basis, Claims 1, 5, 7, 13, 14 and 16 to correct grammatical and/or spelling errors, and Claim 2 at lines 3-4 to delete "ordinary temperature" and substitute therefor "a temperature of 15 to 35°C." Support for the amendment to Claim 2 can be found in the original specification at page 35, line 25. Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

Also in the Office Action, the Examiner has rejected the subject matter of Claims 1, 2 and 5-7 as being obvious over the combination of Kato et al. (JP 10-204,355) (hereinafter "the '355 reference") and U.S. Patent No. 4,718,340 issued to Love, III (hereinafter "the '340 patent"). Applicants respectfully request reconsideration and withdrawal of this rejection.

Essentially, the Examiner contends that the '355 reference teaches all of the limitations of the claims except for imaging the printing plate in press. The Examiner, though, relies upon the '340 patent to teach the desirability of imaging a printing plate in press and therefore asserts that it would have been obvious to one skilled in the art to provide the method of the '355 reference with the step of imaging the plate in press in view of the '340 patent to achieve the claimed invention. In addition, with respect to Claim 7, the Examiner asserts that it would have been obvious to one skilled in the art to use a full line head as disclosed by the '340 patent in the method of the '355 reference to achieve faster imaging of the plate.

The combination of the '355 reference and the '340 patent does not disclose, teach or suggest a method of lithographic printing which comprises forming an image on a printing

plate precursor mounted on a plate cylinder of a printing press in an ink-jet system by ejecting oil-based ink utilizing an electrostatic field to form the image thereby preparing a printing plate and then carrying out printing with a printing press using the obtained printing plate as required by the methods of the present invention.

The '355 reference is directed to an oil-based ink composition for an ink-jet recording system which is entirely different from the method of lithographic printing of the present invention. An offset printing plate using the oil-based ink for the ink-jet recording system is described in the '355 reference at paragraphs [0063] to [0083] and shown in the drawings. In particular, the '355 reference provides that by using the device system (Fig. 1) to carry out the preparation of the offset printing plate based on the information of the image to be formed, droplets of ink are sprayed from the head 10 of the ink-jet recording device 1 onto the master 2 to prepare the plate-making master in which the image has been formed, and subsequently desensitizing treatment is carried out to prepare the printing plate. The '355 reference also provides that in offset printing using the obtained printing plate, the printing of about 10,000 sheets can be performed. Examples 1 to 15 (paragraphs [0097] to [0137]) of the '355 reference further describe preparation of a printing plate and the printing. Paragraph [0101] of the '355 reference, though, provides that the printing is carried out using the obtained printing plate by a whole automatic printing press (AM-2850). Accordingly, the preparation of a printing plate and the printing are carried out by using a separate printing press, respectively.

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The '355 reference does not disclose, teach nor suggest a method in which the preparation of the printing plate and the printing are carried out in the ink-jet on the printing press as required by the present invention.

The '340 patent discloses a printing method in which the image is directly formed on the surface of the plate cylinder of the printing press. However, in the method of the '340 patent, the plate cylinder itself becomes the printing plate and therefore, this method is entirely different from the method of the present invention in which the printing plate precursor is mounted on the plate cylinder. That is, in the present invention, the plate cylinder is a separate factor from the printing precursor.

2

Accordingly, the combination of the '355 reference and the '340 patent does not obviate Claims 1, 2 and 5-7 and this rejection should be withdrawn.

The Examiner has also rejected the subject matter of Claims 3, 4 and 8-17 as being obvious over the combination of the '355 reference and the '340 patent and further in view of either Adler (EP 641,648), Masaaki (JP 58-147,373), U.S. Patent No. 4,555,712 issued to Arway et al., U.S. Patent No. 5,363,132 issued to Ikkatai, U.S. Patent No. 5,322,015 issued to Gasparrini and U.S. Patent No. 5,988,782 issued to Miura et al.

Claims 3, 4 and 8-17 are directly or indirectly dependent upon Claim 1. Thus, as Claim 1 is clearly patentable over the combination of the '355 reference and the '340 patent as discussed above, dependent Claims 3, 4 and 8-17 are also patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 3, 4 and 8-17.

In view of the foregoing, it is submitted that this application is now in condition for allowance and favorable reconsideration and prompt notice of allowance are earnestly solicited.

April 13, 2001 375 Park Avenue, 17th Floor New York, NY 10152 Tel. (212) 521-5400 JEG/SRP:km Respectfully submitted, REED SMITH, LLP

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